

## II. REMARKS

### **Formal Matters**

Claims 1-12, 14-20, 24, 25, 30-32, 39, and 64-97 are pending after entry of the amendments set forth herein.

Claims 1-20 and 22-41 were examined and were rejected. Claims 41-61 were withdrawn from consideration.

Claims 1, 5, 6, 24, and 25 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as acquiescence to any objection or rejection of any claim. The language of claim 23 is incorporated into claim 1. No new matter is added by the amendments to claims 1, 5, 6, 24, and 25.

Claims 13, 22, 23, 26-29, 33-38, and 40-61 are canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Claims 64-97 are added. Support for new claims 64-97 is found in the claims as originally filed, and throughout the specification. Exemplary support for new claims 64-98 is as follows: claims 64-66: claims 27-29; claims 67 and 84: claim 3; claims 68 and 85: claim 4; claims 69 and 86: claim 5; claims 70 and 87: claim 6; claims 71 and 88: claims 7-11; claims 72 and 89: claim 14; claims 73 and 90: claim 15; claims 74 and 91: claim 16; claims 75 and 92: claim 17; claims 76 and 93: claim 19; claims 77 and 94: claim 20; claims 78 and 95: claims 30 and 31; claims 79 and 96: claim 32; claims 80 and 97: claim 39; and claims 81-83: claims 36-38. Accordingly, no new matter is added by these new claims.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### **Rejection under 35 U.S.C. §112, first paragraph**

Claims 1-20, 22, 26, 30-35, 39, and 40 were rejected under 35 U.S.C. §112, first paragraph, as allegedly lacking adequate written description.

Without conceding as to the correctness of this rejection, claim 1 is amended to include the language of claim 23. Claim 23 was not included in this rejection. As such, this rejection, as it may apply to claim 1 and claims depending directly or indirectly therefrom, may be withdrawn.

Applicants note that claims 27-29 were also not included in this rejection. New claims 64-66 are based on claims 27-29. As such, claims 64-66, and claims depending directly or indirectly from claims 64-66, should be deemed allowable. Similarly, claims 36-38 were not included in this rejection. New claims 81-83 are based on claims 36-38. As such, claims 81-83, and claims depending directly or indirectly from claims 81-83, should be

deemed allowable.

Applicants submit that the rejection of claims 1-20, 22, 26, 30-35, 39, and 40 under 35 U.S.C. §112, first paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-20 and 22-40 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

The Office Action stated that it is not clear whether it is intended that the genetic modification present in the cells is intended to be necessarily responsible for the recited production of prenyl diphosphate in an amount effective to inhibit growth.

Claim 1 is amended to recite “wherein said genetic modification results in production of a prenyl diphosphate intermediate in an amount effective to inhibit growth of the genetically modified host cell.” Support for such an amendment (and similar language present in new claims 64 and 81) is found in the specification at, e.g., paragraphs 0079-0082. Applicants believe that the above-noted amendment to claim 1 adequately addresses this rejection of claims 1-20 and 22-40.

Applicants submit that the rejection of claims 1-20 and 22-40 under 35 U.S.C. §112, second paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

### III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number BERK-032.

Respectfully submitted,  
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